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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Bruno Criere

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EXAMINER

GEMBEH, SHIRLEY V

ART UNIT

PAPER NUMBER

1618

NOTIFICATION DATE

DELIVERY MODE

06/13/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary	Application No. 10/677,861	Applicant(s) CRIERE ET AL.	
	Examiner SHIRLEY V. GEMBEH	Art Unit 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34 and 72-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34 and 72-79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) ☐ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413) |
| 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) ☒ Information Disclosure Statement(s) (PTO/SB/08) | 5) ☐ Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/22/08</u> . | 6) ☐ Other: _____ |

DETAILED ACTION

The response filed **4/22/08** presents remarks and arguments to the office action mailed **1/7/08/07**. Applicant's request for reconsideration of the rejection of claims in the last office action has been considered.

Applicant's arguments have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 4/22/08 is acknowledged and has been reviewed.

Status of Claims

Claims 34, 72-79 are pending. Claim 79 is newly added.

Applicant was given copy of the interview summary dated 2/22/08.

Maintained Claim Rejections - 35 USC § 103

Applicant argues that the extent to which the cited art teaches the use of a binding cellulose derivative is substantially greater than $\geq 20\%$ of the teachings of the instantly claimed invention and that the patentable distinction is that the instant invention uses significantly lower quantities and an associated reduction in food effect.

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Applicant argues that Curtet fails to disclose fenofibrate formulations comprising cellulose polymer or specified cellulose derivative. With respect to Boyer, Applicant argues that the formulation do not contain 12.5% by weight of the pharmaceutical formulation. With regard to Stamm Applicant argues that in order to improve fenofibrate bioavailability, the incorporation of higher binding concentration is needed.

In response, after careful consideration of Applicant's argument and the consideration of the Exhibits, it is found that the art is mischaracterized by Applicant. In that in the Stamm reference teaches at col. 3, lines 12-23 the inert layer is covered with at least one layer containing a fenofibrate active ingredient in a micronized form and of at least 20% by weight of the hydrophilic polymer (a). Which further comprises several outer layers (b), thus if other layers are present that substantially decreases the amount of cellulose. The 20% is only with regard to component (a) several layers present would decrease the amount of cellulose in the layer.

The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teachings of the combined cited prior art would have resulted in the claimed invention because the art recognizes micronized fenofibrate form in treating hyperlipidemia and

pharmaceuticals containing a neutral core and surrounding said core is active layer is within the purview of the skilled artisan to make and use.

Claims **34, and 72-79** remain rejected under 35 U.S.C. 103(a) as being unpatentable over www.pslgroup.com/dg taken with Curtet et al., US 4,895,726 and Boyer, US 4,800,079 and Stamm et al. US 6,074,670 (of record) in view of U.S. Department of Health and Human Services Food and Drug Administration Center for Drug Evaluation and Research (CDER) October 1997(of record). www.pslgroup.com/dg teaches administering a micronized form of the drug fenofibrate to a set population with high serum triglyceride and hyperlipedemia. See underlining page 1. The reference fails to teach how the pharmaceutical composition comprising fenofibrate was formed.

Curtet et al teach a pharmaceutical compositions containing fenofibrate, co-micronized in mixture with a solid surfactant. See col. 1, lines 45-50. The composition of fenofibrate further comprises excipients such as polyvinylpyrrolidone, starch, lactose etc (examples) to be filled into the dosage forms such as capsules.

Curtet et al. fail to teach cellulose polymer of the instant claims, nor the percentage of the cellulose binder. However teaches the micronized drug form is the improvement being high bioavailability of fenofibrate together with the polymer, surfactants and other excipients.

Boyer teaches with regards to instant claims 34 and 79 administering micronized fenofibrate to set population with high triglyceride having an inert core comprising the percent of the cellulose binder (methyacrylic polymer) is 12.5%. See abstract, also col.

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1, lines 51-56 and col.2, lines 52-59. It is interpreted that the weight by granules as required by instant claim 79 is taught and is about 1%. See col. 3, lines 31. The term “about” in the reference permits some tolerance and reads on between 2-15%.

Accordingly, the values appear to overlap.

After calculation taking the formulation data given the percentage of the cellulose derivative is 3.7%. (fenofibrate 400 and the cellulose derivative is 20, total formulation is 530). After calculation 20g results in 3.77%).

Stamm et al. teach, with regards to the current claims 34, 72 and 79, the pharmaceutical composition comprising micronized fenofibrate, a surfactant (see col. 1, lines 40-41) and a binder of cellulose derivative such as hydroxymethylpropylmethyl cellulose (see col. 4, lines 19-21) wherein the hydrophilic polymer is from 5-40% by weight (see col. 6, lines 36-37) in a granular form (see col. 3, lines 40-41). With regards to the composition comprising a neutral core (see col. 3, line 15) the patent teaches an inert core (see abstract) wherein the neutral core is an inert hydrosoluble carrier (per definition inert in medical definition is un-reactive and refers to a substance which will not chemically react with anything under normal circumstances –see cancerweb.ncl.ac.uk/cgi-bin/omd?inert of record. Stamm et al. do not teach the binder of cellulose derivative by weight of the composition as in the instant claim 34, nor the ratio of fenofibrate to the binding cellulose derivative as 5/1 and 15/1 as in claim 72 differs from the claimed invention. However, the reference teaches a different ratios between 1/10 and 4/1 (see col. 5, lines 13-15), the determination of such a ranges having the optimum therapeutic index is well within the level of one of ordinary skill in

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the art, and one of ordinary skill in the art would be motivated to determine the optimum amount ratio needed to have the maximum effective effect in the absence of an unexpected result. Hence, the reference makes obvious the instant invention. It is also the Examiners position that once the concept is known or available, one of ordinary skill in the art would be motivated to find the optimum working range. Also it has been held that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine. See *In re Aller*, 220 F.2d 454 105 USPQ 233,235 (CCPA 1955).

The above Stamm cited reference fails to teach the calorie intake of the patient.

U.S. Department of Health and Human Services Food and Drug Administration Center for Drug Evaluation and Research (CDER) October 1997 teaches with regards to instant claims 73-79, administering food changes the physiology of the gastrointestinal tract, wherein a high fat containing approximately 50%(for a 1000 caloric diet the fat calorie is 500-600-thus at least 50%) of total caloric meal, wherein the high caloric diet is approximately 1000 calories (see page 5, under test sec. D). The reference teaches administration in fasted treatments (see page 5, sec E) and the bioavailability calculated (see (see pages 6-7). The reference gave teachings on how to conduct food effect bioavailability. One of ordinary skill in the art would have used the guidance provided by the FDA combined with the above cited references and would have resulted in the claimed invention at the time the claimed invention was made because: the Doboek et al. teach the use of micronized fenofibrates in a neutral core to treat hyperlipidemia, administering a high content of fat containing meal, the binding

cellulose is 15% of the claimed composition cured by the addition of Stamm and USFDA. With regards to reducing food effect, treating hypertriglyceridemia and or hypercholesterolemia and or hyperlipidemia would result in the administration of the drug as the drug micronized fenofibrate is a drug used to treat hyperlipidemia.

Reducing food effect is via treating hyperlipidemia thus administering the drug would lead to reducing food effect. MPEP 2112.01 "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

It would have been obvious to have administered a micronized fenofibrate to treat hypertriglyceride and reduce the food effect simultaneously because it is known that the micronized drug form of fenofibrate results in high bioavailability together with the polymer, surfactants and other excipients.

2. Applicant argues that the www.pslgroup.com/dg is relied upon for the teaching of administration of the micronized form of the drug but fails to show any other material of the claimed compound.

Also, that the FDA CDER reference fails to cure the remedy of the cited references and that Munoz is relied upon for the showing of lipanthyl 200 micronized has reduced food effect.

In response, the combination of the art would have been obvious to one having ordinary skill in the art simple because, in the art as acknowledged by Applicant, the

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micronized form is known in the art and is used for the treatment of hypercholesterolemia. Food effect on drugs is known in the art, the teaching of CDER gives guide lines on how administering food changes the physiology of the gastrointestinal tract, wherein a high fat containing approximately 50% (for a 1000 caloric diet the fat calorie is 500-600-thus at least 50%) of total caloric meal, wherein the high caloric diet is approximately 1000 calories (see page 5, under test sec. D). The reference teaches administration in fasted treatments (see page 5, sec E) and the bioavailability calculated (see (see pages 6-7). The reference gave teachings on how to conduct food effect bioavailability. As to the Munoz reference, the function of the compound would not change whether its in its micronized form or not because the system of the patient would not identify that the drug is having an inert core and an active layer, what the system acknowledges is the drug.

Careful consideration has been given and the rejection is maintained.

Claims **34, and 72-79** remain rejected under 35 U.S.C. 103(a) as being unpatentable over www.pslgroup.com/dg taken with Curtet et al., US 4,895,726 and Boyer, US 4,800,079 and Stamm et al. US 6,074,670 further in view Munoz et al, (Applicants IDS 9/14/06) and MPEP.

Munoz et al teach the digestive absorption of Lipanthyl® 200 Micronized is less influenced by the lipid content of food than standard fenofibrate. The comparison of digestive absorption obtained after administration of Lipanthyl® 200 Micronized and 300 mg of standard fenofibrate during a low fat meal and during a high fat meal, shows that the variation of this absorption is reduced by a factor of three (Fig. 5).

Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103, expressed as a 102/103 rejection. "There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. 103 and for anticipation under 35 U.S.C. 102." In re Best, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977). This same rationale should also apply to product, apparatus, and process claims claimed in terms of function, property or characteristic.

Also as stated in the MPEP, "[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on inherency' under 35 U.S.C. 102, on prima facie obviousness' under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same... [footnote omitted]." The burden of proof is similar to that required with respect to product-by-process claims. In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)).

Double Patenting

Applicant Applicant's request that the Double Patenting rejection be held in abeyance until it is made permanent is noted but will be maintained in this Office Action and future Office Actions until withdrawn.

Claims 34 and 72-79 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim **7-17** of

U.S. Patent Application No. 11/509,806. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claims 34 and 72-79 remain rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-34 of U.S. Patent No. 7,101,574. (This rejection is not addressed by Applicant).

Although the conflicting claims are not identical, they are not patentably distinct from each other. The claims recite a pharmaceutical composition in the treatment of hyperglyceride. See col. 1, lines 9-12. (using the specification as a dictionary).

Both sets of claims describes a micronized fenofibrate composition employing cellulose binding polymer and a surfactant because both instant and the copending claims recite the same composition i.e., comprising granules, each granule comprising a neutral microgranule, fenofibrate particle, a surfactant and a binding cellulose polymer, wherein the cellulose derivative represents 2-15% by weight of the composition.

As to the copending application claims 1-34, these claims refer to a process of making the composition. The composition would have been used in the claimed process of claims 34 and 72-79 in the instant application because they would have been used in the method of treating patients with high cholesterol. Thus, the process of making a composition are part of the obvious variation of the copending application claims compared to the current application claims.

No claim is allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHIRLEY V. GEMBEH whose telephone number is (571)272-8504. The examiner can normally be reached on 8:30 -5:00, Monday- Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL HARTLEY can be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael G. Hartley/
Supervisory Patent Examiner, Art Unit 1618

SVG
6/4/08